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APPLICATION NO. 09/033,303	FILING DATE 11/17/98	FIRST NAMED INVENTOR CHRISTIANSEN	ATTORNEY DOCKET NO. PM-257832
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MM22/0623

EXAMINER SCHWARTZ, M

ART UNIT 2876	PAPER NUMBER
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DATE MAILED: 06/23/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/188,333

Applicant(s)
Christiansen et al

Examiner
Michael J. Schwartz

Group Art Unit
2876



☒ Responsive to communication(s) filed on Nov 9, 1998

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-9 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☒ Claim(s) 1-3 is/are allowed.

☒ Claim(s) 4 is/are rejected.

☒ Claim(s) 5-9 is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been
☒ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hangartner and, in further view of Stein et al (US5748705), filed on September 8, 1995.

In Hangartner's cortical bone evaluation method, it is not specifically stated that the forearm should be the defined area of bone to be assessed.

Stein et al disclose a system for bone densitometry. In column 1, lines 53-55, Stein et al state that the forearm is a typical area of analysis for evaluating projected bone mineral density.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the method of Hangartner to obtain forearm bone data as suggested by the system of Stein et al. This modification would have been obvious because, as implied by Stein et al, in column 1, lines 53-55, and absent any showing of criticality, many different body areas can be scanned individually for the purpose of bone density measurements.

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Allowable Subject Matter

3. Claims 1-3 are allowed.

US Patent No. 5,641,747 issued to Popoff et al on June 24, 1997 discloses a method for treating osteopetrotic diseases. Popoff et al teaches using a bone densitometry device for monitoring the treatment process.

US Patent No. 5,594,775 issued to Hangartner on January 14, 1997 discloses a methods and apparatus for evaluating cortical bone using computer tomography.

The prior art does not disclose a body defining means that is responsive to an operator's choice of a treatment regime out of the treatment regimes for which information is stored as in claim 1.

4. Claims 5-9 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The prior art does not disclose the following:

- scanning an area of trapezoidal shaped bone as in claim 5
- the size and angle of the defined area as in claims 6-7 and 9

Claim 8 is dependent upon claim 5.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Michael J. Schwartz whose telephone number is (703) 306-5435.

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The examiner can normally be reached on Monday to Thursday from 7:00 am to 4:30 p.m. And on alternate Fridays from 7:00 a.m. to 3:30 p.m. In addition, e-mail inquiries can be sent to michael.schwartz@USPTO.gov.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Don Hajec, can be reached on (703) 308-4075. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-7382 or (703) 308-7722.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.



David P. Porta
Primary Examiner